

REMARKS / ARGUMENTS

Claim Disposition

Claims 1 – 22 are pending in the application. Claims 12-22 have been withdrawn due to the Applicants' election with traverse filed on October 20, 2006. Claims 1 – 11 have been rejected. Applicants have amended Claims 2, 3, and 5-11, cancelled Claim 1, and added new Claims 23-26, leaving Claims 2-11 and 23-26 for consideration upon entry of the present Amendment.

Applicants respectfully submit that the rejections under 35 U.S.C. §112, second paragraph and 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Specification

Applicants have amended the Abstract to comply with the proper language and format for an abstract of the disclosure, per MPEP 608.01(b).

Applicants have amended the Title of the invention to be clearly indicative of the invention to which the claims are directed.

Independent Claim 23 is drawn to “An apparatus for attaching a proximity probe...”.

Accordingly, the invention is directed to “An apparatus for attaching a proximity probe...”. As such, Applicants respectfully submit that the amended title “Apparatus for attachment of a probe tip” is indicative of the invention to which the claims are directed, and that the title meets the requirements of MPEP §606.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw these objections, which Applicants consider to be overcome.

Claim Rejections - 35 USC §112

Claims 1-11 stand rejected under U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. Applicants respectfully traverse. The Examiner states in the Office Action:

“The inconsistency between the language in the preamble “an apparatus” and certain portions of the body of claims such as “a proximity probe, a proximity probe offset, an extension cable, a tip of the proximity probe, a fusion, a fusion process, a binder material, a laser weld, electronic components” renders the scope of the claim vague and indefinite because it is unclear if the intent is to claim either the subcombination of the “an apparatus”

alone or the combination of the "an apparatus" and "a proximity probe, a proximity probe offset, an extension cable, a tip of the proximity probe, a fusion, a fusion process, a binder material, a laser weld, electronic components". The applicant is asked to please clarify what subject matter the claim is intended to be drawn to..."

Applicants have cancelled Claim 1 without prejudice or disclaimer.

Claim Rejections - 35 USC § 103(a)

Claims 1-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kerr, et al. U.S. Patent No. 5,960,530, hereinafter referred to as Kerr. Applicants respectfully traverse. The Examiner states:

"Kerr discloses a metal interface cup (36 and 12); probe case (14); a first bore (120); a closed end of the first bore (102); a second bore (132 and where 134 is located); 132 is a portion of the second bore intersects 120; 132 is less than half a diameter of 120; 132 and where 134 is located are two bores; 14 is rectangular; a bore in claim 10 is 116 and 104 lies, except for the case to be made with metal. The Kerr reference provides all the structural elements of the claimed limitations; therefore, Kerr is capable of function as an apparatus for attaching a proximity probe offset to an axis defining a metal probe case and an extension cable extending therefrom. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make the case with metal because Applicant has not disclosed that making the case with metal provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the case to be made with metal to provide strength and durability from continued use."

Applicants respectfully contend that the explanation in the Office Action mischaracterizes the teachings of Kerr and that Kerr does not teach or suggest each element of the invention. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness. *In re Fine*, U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combine references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d,

1016, 1023 (Fed. Cir. 1996). Additionally, Applicant respectfully submits that a prima facie case of obviousness cannot be supported by a proposed modification that would render the prior art invention being modified unsatisfactory for its intended purpose. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984); MPEP §2143.01.

Regarding Independent Claim 1

Applicants have cancelled Claim 1 without prejudice and disclaimer.

Regarding Dependent Claim 7

With regard to Claim 7, Applicants respectfully contend that Kerr does not teach or disclose each element of the invention. Specifically, Kerr does not teach or suggest the claimed “...wherein said fusion includes a laser weld.”

Therefore, because Kerr does not disclose or teach each element of the invention they cannot render Applicants’ claims unpatentable. Thus, Claim 7 is allowable, the rejections are improper, and they should be withdrawn.

Regarding New Independent Claim 23

Applicants have added new Claim 23, which Applicants submit is novel and patentable over the prior art of record for at least the following reasons.

New Claim 23 recites inter alia, “...a metal probe case having a first bore and a second bore, said first bore receptive to said metal interface cup and having a first surface defining a closed end of said first bore, said second bore oriented such that only a portion of said second bore intersects said first surface to create a through hole into said first bore; and a fusion securing said metal interface cup with said metal probe case at an interface between said bottom surface and said second bore...”.

Applicants respectfully submit that Kerr does not disclose the claimed “...such that only a portion of said second bore intersects said first surface to create a through hole into said first bore ...”. Applicants further submit that Kerr is absent disclosure of the claimed “...a fusion securing said metal interface cup with said metal probe case at an interface between said bottom surface and said second bore...”.

In alleging obviousness, the Examiner remarks that one of ordinary skill in the art

would have expected the case of Kerr to be made with metal to provide strength and durability from continued use.

Applicants respectfully disagree, and submit that modification of Kerr to provide the case made with metal would render the invention of Kerr unsatisfactory for its intended purpose. Applicants find Kerr to teach “*The metal collar 36 of the probe 12 is encircled by an electrical contact terminal 102 that is sandwiched between a ledge 100 of the support head 14 (FIG. 12) and the metal flange 38. A conductor 142 establishes electrical communication between the electrical contact 102 and a power source 140 (FIG. 14). Thus electrical power can be provided to the probe 12 from the power source 140.*” [Kerr, Col 6, lines 13-20].

Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to modify Kerr to provide the support head (item 14) made from metal, as such modification would render Kerr unsatisfactory for its intended purpose, because a metal support head 14, via ledge 100, would conduct away (from the contact 102) the electrical power intended to be provided to the probe 12.

Furthermore, Applicants find Kerr to teach “The support head 14 is connected to a rod 15, that is movable upwardly and downwardly, backward and forward, and side to side...by a known drive arrangement...” [Kerr, Col. 3, lines 46-49]

Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to modify Kerr to provide the support head (item 14) made from metal, as such modification would render Kerr unsatisfactory for its intended purpose because additional mass resulting from a metal support head would require an enhanced drive arrangement to provide additional torque.

Accordingly, Applicants submit that Kerr is absent any teaching, suggestion, or motivation for one of ordinary skill in the art to modify the support head to be made from metal for the purpose of arriving at the claimed invention while maintaining Kerr to be satisfactory for its intended purpose. As such, Applicants submit that the modification of Kerr cannot be used to establish a prima facie case of obviousness.

Regarding New Claims 24 -26

Applicants have added new Claims 24-26. Claims 24 and 26 each depend from Claim 23, to now claim disclosed but previously unclaimed subject matter. Claim 25 depends from dependent Claim 24. No new matter has been added as antecedent support may be found in the application as originally filed, such as at Paragraphs [0040], [0042], [0048] and Figures 6,7, 8, and 9 for example.

In view of the remarks set forth above regarding the allowability of Claim 23, Applicants submit that new Claims 24 - 26 are directed to allowable subject matter and respectfully requests entry and allowance thereof.

Regarding Examiner's Paragraph 9

Applicants note the Examiner's paragraph 9 in the office action, however, are aware of no statutory requirement or regulation requiring Applicants to number the claims of an application for patent in the United States. In view hereof, Applicants attorney believes that the time-based cost to Applicants is unwarranted. Applicants therefore request withdrawal of the request to provide reference numerals to all the claimed limitations.

The arguments and amendments presented herein are made for the purposes of better defining the invention, rather than to overcome the rejections for patentability. The claims have not been amended to overcome the prior art and therefore, no presumption should attach that either the claims have been narrowed over those earlier presented, or that subject matter or equivalents thereof to which the Applicants are entitled has been surrendered. Allowance of the claims is respectfully requested in view of the above remarks. Moreover, since, as noted above, no amendments presented alter the scope of the claimed invention and therefore cannot necessitate a new grounds rejection.

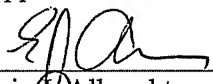
It is believed that the foregoing remarks are fully responsive to the Office Action and that the claims herein should be allowable to the Applicants. In the event the Examiner has any queries regarding the instantly submitted response, the undersigned respectfully requests the courtesy of a telephone conference to discuss any matters in need of attention.

If there are any additional charges with respect to this Response or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully Submitted,
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